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EXAMINER

FELTEN, D

ART UNIT 2076	PAPER NUMBER S
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DATE MAILED: 04/19/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 08/891,261	Applicant(s) Dorf
Examiner Daniel Felten	Group Art Unit 2876

- Responsive to communication(s) filed on Mar 4, 1999
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- Claim(s) 1-66 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 1-66 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claims _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been
- received.
- received in Application No. (Series Code/Serial Number) _____.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-66 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 of this title before the invention thereof by the applicant for patent.

2. Claims 16, 17, 23, 26-28, 57, 60-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Stimson et al (US 5,577,109) (as cited by applicant).

The above claims relate to a prepaid phone card system or method of activating/recharging a prepaid card. Stimson et al teaches a phone card having a unique identification number (see figure 2, column 3, line 61-67); means for activating an account 14 with a balance equal to the phone card activation amount (see column 2, line 61 to column 3, line 6); means for allowing a user of the phone card to obtain long distance telephone calling time (see column 2, lines 31-33); means for decreasing the balance of the account (see column 10, lines 33-35) swiping the card though an existing standard retail point of sale (see column 6, lines 13-20).

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3. Claims 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Pritchard (US 4,491,725).

Pritchard discloses a multifunction card system that has a debit/medical services card with a unique identification number on it (see column 5, lines 25-32); a transaction processor 20 receiving data from a point of sale device (see column 6, lines 8-12); a processing hub 26 receiving directly and indirectly card data from transaction processor (see column 4, lines 54-56); and processing hub accessing a first database 40 when the card functions as a debit card (see column 4, lines 59-64, and column 5, lines 7-12); and the processing hub accessing second database 36 when the card functions as a medical card (see column 6, lines 33-46).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson (US 5,577,109).

Regarding claim 18: Stimson teaches all the element that meets claimed limitation. Stimson fails to explicitly teach that the first digit of the bank identification number is selected

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from the group consisting of four or five. However, since the applicant discloses in the specification that the first digit of the applicant's identification number is the same as that of the first digit of a notoriously old and well known card issuer (see the Specification, page 7, first paragraph), it would have been obvious to an artisan of ordinary skill at the time of the invention to modify the identification number of Stimson such that it would be accepted by the popularly used, and well known POS devices- providing for more widespread use of Stimson's card. Therefore such a modification, would have constituted an obvious expedient well within the ordinary skill in the art.

Regarding claim 19: Stimson also fails to explicitly teach that when the phone card when is swiped through the point of sales device it employs a banking network. However, since Stimson discloses the fact that the terminals may be implemented in existing machines (e.g., credit card, ATM, or money order machines) that are notoriously well known to be integrated into the banking network (see column 6, lines 13-20 and lines 41-44), it would have been obvious to an artisan of ordinary skill at the time of the invention to have a point-of-sale device that when the phone card is swiped through the point of sales device it employs a banking network, because such a modification would have provided a way of purchasing goods and services through the card without using hard currency. Therefore, such a modification would have constituted an obvious expedient well within the ordinary skill in the art.

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6. Claims 1-5, 8-11, 34-44, 46, and 50-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson et al (US 5,577,109) and Nguyen et al (US 5,815,561) (newly cited) in view of each other.

Stimson et al discloses a pre-paid credit card system with an identification number 22 on the card (see column 3, lines 64-67 and column 6, lines 30-34), a main processor for various transactions (see column 6, lines 45-65), as well as a point of sale device 14 (see figures 1 and 3, column 4 lines 16-29) that allows the user to swipe the card to make a transaction like a standard retail terminal (see column 6, lines 13-20). Although Stimson et al teaches the use of many different types of cards that can be used in his invention (see column 6, lines 34-38), Stimson et al does not explicitly disclose that his card is an electronic gift certificate. Nguyen et al teaches that telephone cards/prepaid cards may function as gift certificates (see column 2 lines 45+). In view of the teaching of Nguyen, it would have been obvious to an artisan of ordinary skill in the art to integrate features of an electronic gift certificate into the prepaid card system of Stimson et al because such a modification would have been desirable to expand the use of the prepaid calling card in order make purchases of a particular goods and services at a limited amount.

7. Claims 6, 7, 12-15; 45, 47-49; and 55, 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson et al (US 5,577,109) as modified by Nguyen et al (US 5,815,561) as applied to independent claims 1, 34, and 50 respectively as discussed above, and further in view

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of Taylor (US 5,530,232) (cited by applicant). The teachings of Stimson et al as modified by Nguyen et al have been discussed above.

Stimson et al as modified by Nguyen fails to disclose associated loyalty data with the use of a card as well as the use of a loyalty card with means for crediting an account corresponding to the loyalty card. Taylor discloses a multifunction data card system that may be used with the conventional magnetic stripe or as a smart card that has means for crediting an account corresponding to the card with loyalty points based upon the purchase data (see figure 5, column 5, lines 29-32). In view of Taylor it would have been obvious to an artisan of ordinary skill at the time of the invention to integrate the teachings of Taylor into the invention of Stimson et al as modified by Nguyen et al because such a modification would have provided means for vendors to reward loyal customers with an added incentive for continue to make more purchases as well as being having the ability to provide stored medical information with respective databases (see column 7, lines 36 to column 8, lines 1-6).

8. Claims 20-22, 24, 25, 29-31 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (US 5,530,232) and Stimson et al (US 5,577,109) in view of each other.

Taylor discloses a multifunction data card system that has functions as a loyal card that has an identification number encoded on it (see column 5, lines 12-16); and means for crediting an account corresponding to the loyalty card with loyalty points upon the purchase data (see column 5, lines 29-31).

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Stimson et al discloses a method of activating a prepaid card having an identification number encoded on it and comprising the steps of: swiping the card through an existing point of sale (POS) device (see column 6, lines 13-20), entering an amount into the POS (see column 4, lines 37-47), transmitting an id number and the amount from the POS device to the processing hub (see column 6, lines 29-44), crediting an account balance with the amount (see column 5, lines 28-37); allowing a user to purchase goods and services using the card (see column 6, line 66 to column 7, line 2), and allowing a user of the card to obtain long distance telephone calling time using the card (see column 2, line 31-33).

In view of Stimson it would have been obvious to an artisan of ordinary skill at the time of the invention to modify Stimson et al's invention with the loyalty capabilities of Taylor because such a modification would have been useful as for promotional purposes for the selling party as an incentive to the user to continue to a particular good or service and to also continue to use the card.

On the other hand, in view of Taylor's disclosure, it would have been obvious to an artisan of ordinary skill in the art at the time of the invention to integrate the teachings of Taylor, a method that associates loyalty data upon the usage of the card and transfers loyalty data to the card in the pre-paid card system/method of Stimson et al, because such a modification of Stimson et al's method would be advantageous in tracking the number of purchases made of a particular good or service by the customer as well as give the customer motivation to continue to purchase a particular good or service.

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9. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson et al (US 5,577,109) in view of Taylor (US 5,530,232).

Stimson et al fails to explicitly disclose the step of associating loyalty data upon the usage of the card and transferring loyalty data to a phone card issuer. Taylor discloses a method that associates loyalty data upon the usage of the card and transfers loyalty data to the phone card user (see figure 5, column 5, lines 29-33).

10. Claims 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson et al (US 5,530,232) in view of Bertina et al (US 5,682,027).

Stimson et al discloses a multifunction card system comprising: an identification number (see figure 2, column 3, line 61-67), a transaction processor receiving card activation data from an existing standard retail point of sale (see column 2, lines 1-4), a processing hub receiving directly or indirectly said activation data from said transaction processor (see column 3, lines 7-9); and a processing hub activating an account corresponding to the unique identification number (see column 3, lines 15-21). Stimson et al fails to explicitly disclose a multifunction card system wherein the card is selected from the group or functions as an electronic gift certificate card, a phone card, a loyalty card, and a medical information card. Bertina et al discloses a system which would allow the card to be used as an gift certificate card, phone card, loyalty card, and medical information card by using several separate storage areas for a number of different applications (see column 15, lines 25-46). Since Stimson et al teaches the ability to use both

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smart and dumb cards in his system (see column 3, line 67 to column 4, line 4), it would have been obvious to an artisan of ordinary skill in the art at the time of the invention, in view of Bertina's teaching, to employ the use of separate storage areas to Stimson et al's system as well as the use of either a smart card and/or a dumb card, because each type of card would have been advantageous in the security aspects of the system in regards to transactions/applications of the system in providing goods and services to the card holder, or providing information between the cardholder and/or the selling party.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ***Daniel S. Felten*** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:30AM to 4:30PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Hajec, can be reached on (703) 308-7045. The fax phone number for this Group is (703)308-7382 or (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [daniel.felten@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly

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set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1 195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

DSF

April 6, 1999


Donald Hajec
Supervisory Patent Examiner
Technology Center 2800